

REMARKS

The outstanding issues are as follows:

- Claims 1-11, and 14-43 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of U.S. Patent No. 6,658,419;
- Claims 1-11, and 14-18, 19-29, 30-39, and 40-43 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of U.S. Patent No. 6,535,882;
- Claims 1-43 and 46-47 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of U.S. Patent No. 6,272,493;
- Claims 1-3, 6-11, 14-22, 24-32, and 35-47 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of U.S. Patent No. 6,636,856;
- Claims 1-5, 7, 11, 13-23, 25, 29-34, 40, 43, and 47 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of U.S. Patent No. 6,434,563;
- Claims 12-13 and 44-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,658,419;
- Claims 12-13 and 44-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,535,882;
- Claims 44-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,272,493;
- Claims 1-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,321,209, and Application Numbers 09/838,927; 09/859,928; 10/175,675; and 11/188,764;

- Claims 1-47 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lemay et al., “Laura Lemay’s Web Workshop JavaScript,” hereinafter *Lemay*.

Applicant hereby traverses the outstanding objections and rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-47 are pending in this application.

I. AMENDMENTS

Applicant has amended claim 19 to correct a grammatical error. Applicant has added “and” between the last two limitations of claim 19. This amendment was purely to correct a grammatical error and does not limit or affect the scope of claim 19 in any way. No new matter was added.

II. DOUBLE PATENTING REJECTIONS

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The Examiner has rejected many of the pending claims under both the “same invention” type double patenting based on 35 U.S.C. § 101 and under the judicially created doctrine of “nonstatutory obviousness-type” double patenting.

A. *Same Invention Double Patenting*

Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. § 101. A rejection based on double patenting of the “same invention” type finds its support in the language of § 101, which states, “whoever invents or discovers any new and useful process ... may obtain a patent therefor” Thus, the term “same invention,” in this context, means an invention drawn to ***identical subject matter***. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438 (CCPA 1970); and *In re Ockert*, 245 F.2d 467 (CCPA 1957) (emphasis added). A reliable test to determine double patenting is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *Vogel*, 422 F.2d 438.

1. U.S. Patent No. 6,658,419

The Examiner rejected claims 1-11 and 14-43 under 35 U.S.C. 101 as claiming the same invention as that in claims 1-11 of U.S. Patent No. 6,658,419 ('419 patent). In order for a double patenting rejection to be appropriate, the inventions claimed in both the application and the asserted patent must be drawn to *identical subject matter*. See *Miller*, 151 U.S. 186; *Vogel*, 422 F.2d 438; and *Ockert*, 245 F.2d 467. In the present case, claims 1-11 and 14-43 are not drawn to *identical subject matter*. Claim 1 of the '419 patent provides, in pertinent part:

... said at least one window object corresponding to at least one executable program object and being controlled by said processing without requiring said content manifestation environment to be refreshed, said controllable attribute configured to permit at least one window object to be controlled as a result of performing at least one of a moving operation, resizing operation, a minimizing operation or maximizing operation within said content manifestation environment.

Thus, every claim of the '419 patent includes each and every of these enumerated limitations.

In contrast, none of the independent claims of the present application includes all of these same limitations. Some of the dependent claims, such as claim 8, include a single one of these limitations added to the dependent claims, e.g., "... wherein said controllable attributes associated with said at least one window object permit said at least one window object to be resized within said content manifestation environment." However, there is no single claim within the present application that requires each of the limitations enumerated in claim 1 of the '419 patent, as quoted above. Therefore, a possibility exists that claim 1 of the pending application could be literally infringed without any of claims 1-11 of the '419 patent also being literally infringed. Thus, the Examiner's statutory double patenting rejection is improper.

Applicant asserts that the Examiner is confusing domination with double patenting. One patent application "dominates" a second patent when the first application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in the second patent. Domination by itself, i.e., in the absence of

statutory or nonstatutory double patenting grounds cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15 (CCPA 1964). As noted above, the '419 patent does not claim **identical subject matter** as the claimed invention. Therefore, the domination of the present application alone cannot arise to double patenting.

2. *U.S. Patent No. 6,535,882*

The Examiner rejected claims 1-11, and 14-18, 19-29, 30-39, and 40-43 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 and 16 of U.S. Patent No. 6,535,882 ('882 patent). As noted above, the inventions claimed in both the application and the asserted patent must be drawn to **identical subject matter**. See *Miller*, 151 U.S. 186; *Vogel*, 422 F.2d 438; and *Ockert*, 245 F.2d 467. In the present case, claims 1-11, and 14-18, 19-29, 30-39, and 40-43 are not drawn to **identical subject matter**. Claims 1 and 6 of the '882 patent provides, in pertinent part:

... said at least one window object corresponding to at least one executable program object and being controlled by said processing engine without requiring said content manifestation environment to be refreshed, said at least one window object is associated with a controllable attribute, said controllable attribute configured to permit at least one window object to be controlled as a result of performing at least one of a moving operation, a resizing operation, a minimizing operation, or a maximizing operation within said content manifestation environment.

Claim 16 of the '882 patent provides, in pertinent part:

... and said controllable attribute associated with said window object permitting said window object to be controlled as a result of performing at least one of a moving operation, a resizing operation, a minimizing operation and a maximizing operation within said content manifestation environment and without requiring said web browser client to refresh said content manifestation environment.

Thus, each of claims 1-11 and 16 of the '882 patent includes each and every of these enumerated limitations, respectively.

In contrast, none of the independent claims of the present application includes all of these same limitations. As noted above, some of the dependent claims, such as claim 8, include a single one of these limitations added to the dependent claims, e.g., "... wherein said controllable attributes associated with said at least one window object permit said at least one window object to be resized within said content manifestation environment." However, there is no single claim within the present application that requires each of the limitations enumerated in claims 1, 6, or 16 of the '882 patent, as quoted above. Therefore, a possibility exists that claim 1 of the pending application could be literally infringed without any of claims 1-11 and 16 of the '882 patent also being literally infringed. Thus, the Examiner's statutory double patenting rejection is improper.

As Applicant asserted above, the Examiner is confusing domination with double patenting. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15 (CCPA 1964). Therefore, the domination of the present application alone cannot arise to double patenting.

3. *U.S. Patent No. 6,272,493*

The Examiner rejected claims 1-43 and 46-47 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of U.S. Patent No. 6,272,493 ('493 patent). As noted above, the inventions claimed in both the application and the asserted patent must be drawn to **identical subject matter**. See *Miller*, 151 U.S. 186; *Vogel*, 422 F.2d 438; and *Ockert*, 245 F.2d 467. In the present case, claims 1-43 and 46-47 are not drawn to **identical subject matter**. Claim 1 of the '493 patent provides, in pertinent part:

... and said controllable attribute associated with said window object permitting said window object to be controlled as a result of performing at least one of a moving operation, a resizing operation, a minimizing operation and a maximizing operation within said content manifestation environment and without requiring said web browser client to refresh said content manifestation environment.

Thus, every claim of the '493 patent includes each and every of these enumerated limitations.

In contrast, none of the independent claims of the present application includes all of these same limitations. As noted above, some of the dependent claims, such as claim 8, include a single one of these limitations added to the dependent claims, e.g., "... wherein said controllable attributes associated with said at least one window object permit said at least one window object to be resized within said content manifestation environment." However, there is no single claim within the present application that requires each of the limitations enumerated in claim 1 of the '493 patent, as quoted above. Therefore, a possibility exists that claim 1 of the pending application could be literally infringed without any of the claims of the '493 patent also being literally infringed. Thus, the Examiner's statutory double patenting rejection is improper.

As Applicant asserted above, the Examiner is confusing domination with double patenting. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15 (CCPA 1964). Therefore, the domination of the present application alone cannot arise to double patenting.

4. *U.S. Patent No. 6,363,856*

The Examiner rejected claims 1-3, 6-11, 14-22, 24-32, and 35-47 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 5-8 of U.S. Patent No. 6,636,856 ('856 patent). As noted above, the inventions claimed in both the application and the asserted patent must be drawn to ***identical subject matter***. See *Miller*, 151 U.S. 186; *Vogel*, 422 F.2d 438; and *Ockert*, 245 F.2d 467. In the present case, claims 1-3, 6-11, 14-22, 24-32, and 35-47 are not drawn to ***identical subject matter***. Claim 1 of the '856 patent provides, in pertinent part:

... said controllable attributes configured to affect manifestation of said at least one window object by permitting said at least one window object to be controlled as a result of performing at least one of a moving operation, a resizing operation, a minimizing operation and a maximizing operation by said web browser client within said content manifestation environment without requiring said content manifestation environment to be refreshed.

Thus, every claim of the '856 patent includes each and every of these enumerated limitations.

In contrast, none of the independent claims of the present application includes all of these same limitations. As noted above, some of the dependent claims, such as claim 8, include a single one of these limitations added to the dependent claims, e.g., "... wherein said controllable attributes associated with said at least one window object permit said at least one window object to be resized within said content manifestation environment." However, there is no single claim within the present application that requires each of the limitations enumerated in claim 1 of the '856 patent, as quoted above. Therefore, a possibility exists that claim 1 of the pending application could be literally infringed without any of the claims of the '856 patent also being literally infringed. Thus, the Examiner's statutory double patenting rejection is improper.

As Applicant asserted above, the Examiner is confusing domination with double patenting. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15 (CCPA 1964). Therefore, the domination of the present application alone cannot arise to double patenting.

5. *U.S. Patent No. 6,434,563*

The Examiner rejected claims 1-5, 7, 11, 13-23, 25, 29-34, 40, 43, and 47 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-5, 7, 13, and 17-18 of U.S. Patent No. 6,434,563 ('563 patent). However, the '563 patent only has 15 total claims. Therefore, for purposes of responding to this rejection, Applicant will use claims 1-15 of the '563 patent.

As noted above, the inventions claimed in both the application and the asserted patent must be drawn to **identical subject matter**. See *Miller*, 151 U.S. 186; *Vogel*, 422 F.2d 438; and *Ockert*, 245 F.2d 467. In the present case, claims 1-5, 7, 11, 13-23, 25, 29-34, 40, 43, and 47 are not drawn to **identical subject matter**. Claim 1 of the '493 patent provides, in pertinent part:

... said at least one corresponding window object configured to manifest
at least a portion of said content therein without requiring said content

manifestation environment to be refreshed, said at least one corresponding window object is associated with a controllable attribute, said controllable attribute configured to permit said at least one corresponding window object to be controlled as a result of performing at least one of a moving operation, a resizing operation, a minimizing operation, or a maximizing operation within said content manifestation environment.

Claim 6 also provides in pertinent part:

... said set of at least one controllable attribute configured to affect manifestation of said at least one corresponding window object by the network client within said content manifestation environment by permitting said at least one corresponding window object to be controlled as a result of performing at least one of a moving operation, a resizing operation, a minimizing operation, or a maximizing operation within said content manifestation environment without requiring said content manifestation environment to be refreshed.

Thus, each of claims 1-5 and 6-15 of the '563 patent includes each and every of these enumerated limitations, respectively.

In contrast, none of the independent claims of the present application includes all of these same limitations. As noted above, some of the dependent claims, such as claim 8, include a single one of these limitations added to the dependent claims, e.g., "... wherein said controllable attributes associated with said at least one window object permit said at least one window object to be resized within said content manifestation environment." However, there is no single claim within the present application that requires each of the limitations enumerated in claims 1 or 6 of the '563 patent, as quoted above. Therefore, a possibility exists that claim 1 of the pending application could be literally infringed without any of the claims of the '563 patent also being literally infringed. Thus, the Examiner's statutory double patenting rejection is improper.

As Applicant asserted above, the Examiner is confusing domination with double patenting. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15 (CCPA 1964). Therefore, the domination of the present application alone cannot arise to double patenting.

B. Nonstatutory Obviousness-Type Double Patenting

Applicant has filed herewith a terminal disclaimer to overcome the Nonstatutory Obviousness-Type Double Patenting rejections to the '419, '882, '493 patents, and U.S. Patent No. 6,321,209 ('209 patent). Applicant terminally disclaims claims 12-13 and 44-45 for the terminal part of the term of the '419 patent. Applicant terminally disclaims claims 12-13 and 44-47 for the terminal part of the term of the '882 patent. Applicant terminally disclaims claims 44-45 for the terminal part of the term of the '493 patent. Applicant also terminally disclaims claims 1-47 for the terminal part of the term of the '209 patent. Based on the terminal disclaimer, Applicant respectfully asserts that the Examiner's rejections are now moot.

The Examiner has improperly attempted to issue nonstatutory obviousness-type double patenting rejections of the present invention to pending application serial numbers 09/838,927; 09/859,928; 10/175,675; and 11/188,764. Because the pending applications have yet to issue as patents, the Examiner is required to issue a provisional rejection on the grounds of double patenting. *In re Mott*, 539 F.2d 1291 (CCPA); *In re Wetterau*, 356 F.2d 556. Applicant, therefore, respectfully requests the Examiner to withdraw the rejections of record and re-issue the appropriate provisional rejections.

III. REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 1-47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Lemay*.

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See* M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." *See* M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

A. Claims 1-13

Claim 1 requires, "... to process said software system and said associated content to produce at least one window object within said content manifestation environment" The Examiner alleges that *Lemay* teaches this limitation through its notation of JavaScript's frames capability. March 6, 2006, Office Action, p. 14. It is well-known by those skilled in the art that one of the capabilities of JavaScript is to code or script frames or framesets, which are used to divide a Web page display into multiple sections. However, it is also well-known by those skilled in the art that JavaScript does not require the use of frames or framesets in each script written by a developer. In its description of the types of scripts that may be processed, *Lemay* only describes one of those types as producing a result that affects the display of a page. *Lemay*, p. 11. Therefore, the use of JavaScript, both in general and as disclosed in *Lemay*, would not result in the production of "at least one window object within said content manifestation environment," as required by claim 1. The mere capability to script frames is not the same as producing at least one frame in each script. Thus, Applicant respectfully asserts that, for the above reason, claim 1 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 2-13 depend directly from base claim 1, respectively, and thus inherit all of claim 1's limitations. Based on this dependency, claims 2-13 set forth features and limitations not recited by *Lemay*. Thus, the Applicants respectfully assert that for the above reasons claims 1-13 are patentable over the 35 U.S.C. § 102 rejection of record.

B. Claims 14-18

Claim 14 requires, "... to process said content to produce at least one window object within said content manifestation environment" As noted above, the Examiner alleges that *Lemay's* notation of JavaScript's frames capability is the same as this limitation. March 6, 2006, Office Action, p. 14. It is well-known by those skilled in the art that JavaScript does not require the use of frames or framesets in each script written by a developer. Therefore, the use of JavaScript would not result in the production of "at least one window object within said content manifestation environment," as required by claim 14. Thus, Applicant

respectfully asserts that, for the above reason, claim 14 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 15-18 depend directly from base claim 14, respectively, and thus inherit all of claim 14's limitations. Based on this dependency, claims 15-18 set forth features and limitations not recited by *Lemay*. Thus, the Applicants respectfully assert that for the above reasons claims 14-18 are patentable over the 35 U.S.C. § 102 rejection of record.

C. Claims 19-29

Claim 19 requires, "... processing said software system and said associated content to produce at least one window object within said content manifestation environment ...". As noted above, the Examiner alleges that *Lemay*'s notation of JavaScript's frames capability is the same as this limitation. March 6, 2006, Office Action, p. 14. It is well-known by those skilled in the art that JavaScript does not require the use of frames or framesets in each script written by a developer. Therefore, the use of JavaScript would not result in the production of "at least one window object within said content manifestation environment," as required by claim 19. Thus, Applicant respectfully asserts that, for the above reason, claim 19 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 20-29 depend directly from base claim 19, respectively, and thus inherit all of claim 19's limitations. Based on this dependency, claims 20-29 set forth features and limitations not recited by *Lemay*. Thus, the Applicants respectfully assert that for the above reasons claims 19-29 are patentable over the 35 U.S.C. § 102 rejection of record.

D. Claims 30-39

Claim 30 requires, "... to process said content to produce at least one window object within said content manifestation environment". As noted above, the Examiner alleges that *Lemay*'s notation of JavaScript's frames capability is the same as this limitation. March 6, 2006, Office Action, p. 14. It is well-known by those skilled in the art that JavaScript does not require the use of frames or framesets in each script written by a developer. Therefore, the use of JavaScript would not result in the production of "at least one window object within

said content manifestation environment,” as required by claim 30. Thus, Applicant respectfully asserts that, for the above reason, claim 30 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 31-39 depend directly from base claim 30, respectively, and thus inherit all of claim 30’s limitations. Based on this dependency, claims 31-39 set forth features and limitations not recited by *Lemay*. Thus, the Applicants respectfully assert that for the above reasons claims 30-39 are patentable over the 35 U.S.C. § 102 rejection of record.

E. Claims 40-47

Claim 40 requires, “... said web browser client to generate a windowed content manifestation environment therein and to produce at least one window object within said content manifestation environment” As noted above, the Examiner alleges that *Lemay*’s notation of JavaScript’s frames capability is the same as this limitation. March 6, 2006, Office Action, p. 14. It is well-known by those skilled in the art that JavaScript does not require the use of frames or framesets in each script written by a developer. Therefore, the use of JavaScript would not result in the production of “at least one window object within said content manifestation environment,” as required by claim 40. Thus, Applicant respectfully asserts that, for the above reason, claim 40 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 41-47 depend directly from base claim 40, respectively, and thus inherit all of claim 40’s limitations. Based on this dependency, claims 41-47 set forth features and limitations not recited by *Lemay*. Thus, the Applicants respectfully assert that for the above reasons claims 40-47 are patentable over the 35 U.S.C. § 102 rejection of record.

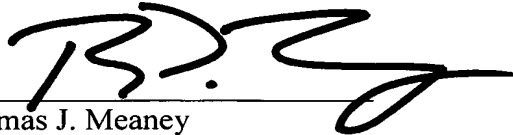
IV. CONCLUSION

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 65164-P006C1C2C1-10606085 from which the undersigned is authorized to draw.

Dated:

Respectfully submitted,

By 

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